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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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EXAMINER

SCHWADRON, R

ART UNIT

PAPER NUMBER

1644

8

DATE MAILED:

05/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action SummaryApplication No.
09/189,702

Applicant(s)

Sette et al.Examiner
Ron Schwadron, Ph.D.Group Art Unit
1644

- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-6 _____ is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-6 _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claim 1 is drawn to an immunogenic peptide which binds HLA 2.1, classified in Class 514, subclass 2.

II. Claim 2 is drawn to a method of inducing a CTL response restricted by HLA 2.1, classified in Class 424, subclass 193.1.

III. Claim 3 is drawn to an immunogenic peptide which binds HLA 3.1/11.1, classified in Class 514, subclass 885.

IV. Claim 4 is drawn to a method of inducing a CTL response restricted by HLA 3.1/11.1, classified in Class 424, subclass 184.1.

V. Claim 5 drawn to an immunogenic peptide which has a B7-like super motif, classified in Class 514, subclass 15.

VI. Claim 6 is drawn to a method of inducing a CTL response restrict by a B7-like supermotif, classified in Class 424, subclass 185.1.

2. Inventions I,III,V are different products. These peptides are chemically, structurally and functionally distinct and bind different types of MHC class I molecules. These products have different art recognized uses (eg. they can only be used to stimulate CTL which are restricted by the appropriate MHC class I allele). Therefore they are novel and unobvious in view of each other and are patentably distinct.

3. Inventions II,IV,VI are different methods. These methods use peptides which are chemically, structurally and functionally distinct and bind different types of MHC class I molecules. These methods have different art recognized uses (eg. stimulating different types of MHC restricted CTL which are restricted by a particular MHC class I allele wherein the art recognizes that different types of MHC class I molecules are structurally and functionally unique). Therefore they are novel and unobvious in view of each other and are patentably distinct.

4. Inventions I/II or III/IV or V/VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the

product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product could be used to detect CTL in an in vitro assay.

5. Because these inventions are distinct for the reasons given above and the search required for any group from Groups I-VI is not required for any other group from Groups I-VI and Groups I-VI have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.

6. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

7. Applicant is required to elect the following species (as they pertain to the elected invention).

8. This application contains claims directed to the following patentably distinct species of the claimed invention:

Any one specific peptide recited in the claims of the invention which applicant chooses above (eg. if applicant elects invention I, a peptide such as SEQ. ID. 44)

These peptides are structurally and functionally distinct and encode peptides that are structurally and functionally distinct, and derived from different proteins with different functions.

Applicant is required under 35 U.S.C. § 121 to elect a single disclosed species, even though this requirement is traversed.

9. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P.

Art Unit 1644

§ 809.02(a).

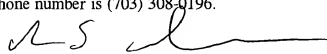
Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

10. Papers related to this application may be submitted to Group 1600 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Papers should be faxed to Group 1600 at (703) 308-4242.

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Dr. Ron Schwadron whose telephone number is (703) 308-4680. The examiner can normally be reached Monday through Thursday from 7:30 to 6:00. A message may be left on the examiners voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Ms Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703) 308-0196.

Ron Schwadron, Ph.D.
Primary Examiner
Art Unit 1644



RONALD B. SCHWADRON
PRIMARY EXAMINER
GROUP 1600-1600